IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Hodges, *et al.*   **Group Art Unit:** 2151

Application No.: 10/720,941   **Examiner:**   Tran

Filed: November 24, 2003   **Attorney Docket:** 030006

Title: "Methods for Providing Communications Services"

PRE- APPEAL BRIEF REQUEST FOR REVIEW

The Assignee requests review of the final rejection in the above-identified patent application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The Office rejected claims 1-20 under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent Application Publication 2006/0041679 to Feig in view of U.S. Patent Application Publication 2005/0094725 to Hui and further in view of U.S. Patent Application Publication 2004/0267686 to Chayes, *et al.*

The pending claims, however, cannot be obviated by the cited documents. As the Assignee has previously argued, any proposed combination involving *Feig* with *Chayes* would require "impermissible changes" to either *Feig's* or *Chayes'* principle of operation. If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. *See* M.P.E.P. at § 2143.01. Any proposed combination involving *Feig* with *Chayes*, then, cannot support a *prima facie* case for obviousness. Moreover, the Assignee previously explained these "impermissible changes," but the Office failed to provide an adequate response.

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The Assignee, then, requests a panel review for the reasons stated below.

1.   Due Process Requires an Adequate Response

The Office has committed clear error in failing to provide Due Process. The Assignee has previously argued that any combination of *Feig* with *Chayes* would require "impermissible changes" to either *Feig's* or *Chayes'* principle of operation. The Assignee has pointed out how *Feig* with *Chayes* must have their respective principles of operation changed to support the Office's *prima facie* cases. The Office, however, has failed to adequately respond to this argument. The Office merely responded by reiterating how the pending claims are allegedly obvious. The Office did not adequately respond to, nor does the Office seem to understand, the "impermissible changes" standard. Due Process, then, requires that the Office consider these "impermissible changes" and provide a response supported by evidence. Any other action is a violation of the Assignee's Due Process safeguards.

This procedural mistake is clear error. The Panel is thus respectfully requested to remove the final rejection of the pending claims. The Appellant also respectfully requests that the Panel remand the application back to the Examiner for an adequate response to the Appellant's "impermissible changes" argument.

2.   The Office Has Failed to Carry the Burden

The Office has committed another clear error. The Office has failed to carry its burden of responding to the Appellant's "impermissible changes" argument. When the Appellant presented evidence that "impermissible changes" were required to support the *prima facie* case, the Office had the burden of rebuttal. The Office, instead, responded by merely repeating the obviousness rejection.

The Office has failed its burden. The Appellant has argued and submitted compelling evidence that *Feig* with *Chayes* would require "impermissible changes" to either *Feig's* or

Chayes' principle of operation to support the *prima facie* case for obviousness. The burden then shifted to the Office for acquiescence or for a factual rebuttal. The Office, instead, incorrectly responded by repeating the obviousness rejection without providing any rebuttal regarding the impermissible changes to principle of operation argument provided by the Appellant. The Office must either i) acquiesce or ii) present evidence detailing why the proposed combination of *Feig* with *Chayes* would not require "impermissible changes." As the Office did neither, the Office failed its burden.

This procedural mistake is clear error. The Panel is thus respectfully requested to remove the final rejection of the pending claims. The Appellant also respectfully requests that the Panel either allow the application or remand the application back to the Examiner for an adequate response to the Appellant's "impermissible changes" argument.

3.   **Because *Feig* with *Chayes* Requires "Impermissible Changes," the § 103 (a) *Prima Facie* Cases for Obviousness Fail**

The Office finally rejected the pending claims under § 103 (a) as allegedly being obvious over *Feig, Hui,* and *Chayes*.

The proposed combination of *Feig* with *Chayes*, however, requires impermissible changes to the principle of operation of either *Feig* or *Chayes*. If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. *See* M.P.E.P. at § 2143.01.

The Examiner's *prima facie* case requires impermissible changes to either *Feig's or Chayes'* principle of operation. As the Assignee has previously stated on the record, *Feig's* principle of operation is to strip individual frames from a multimedia file and then packetize the frames. As the Assignee has also previously stated, *Chayes'* principle of operation is to obtain "newsgroup data," create a "weighted graph" of the newsgroup data, "recursively" segment the weighted graph into clusters, and then output the results. If the teachings of *Chayes* are

combined with *Feig*, as the Office proposes, then *Feig's* principle of operation must be impermissibly changed.

Chayes' principle of operation is to generate "a weighted cluster graph of newsgroups utilizing cross-posting information." U.S. Patent Application Publication 2004/0267686 to Chayes, *et al.* at paragraph [0044]. *Chayes* first explains that "newsgroup data" is received. *Id.* at paragraph [0044]. Although the newsgroup data can be "formatted in any suitable manner," *id.* at [0044], *Chayes* only teaches receiving the "newsgroup data" as "matrices and arrays." *Id.* at paragraphs [0045], [0046], and [0058] – [0060]. A "weighted graph" is then generated, "which depicts relatedness of two or more newsgroups." *Id.* at paragraph [0048]. The "newsgroups [are] represented as vertices and [the] cross-posts [are] represented as edges." *Id.* at paragraph [0063]. The weighted graph is then "recursively segmented into clusters" of highly related newsgroups using a clustering algorithm (such as "spectral clustering algorithms"). *Id.* at paragraph [0066]. *See also* U.S. Patent Application Publication 2004/0267686 to Chayes, *et al.* at paragraphs [0052] and [0053]. After segmentation, clusters are merged if substantially related to one another. *See id.* at paragraph [0067].

Chayes explains that "recursive segmentation" of the weighted graph is determined using eigenvectors. *See id.* at paragraphs [0075] and [0078]. "Prior to performing any segmentation, a segmentation value is defined and vertices of a weighted graph are divided into at least two segments." *Id.* at paragraph [0079]. Eigenvectors are computed and an "Mcut ratio" is computed. *Id.* at paragraphs [0081] and [0082]. The "Mcut ratio" is compared to a threshold for determining cluster sizes. *Id.* at paragraphs [0083] through [0086].

Any proposed combination of *Feig* with *Chayes*, then, is impermissible. As the above paragraphs illustrate, if *Chayes* is combined with *Feig*, as the Office proposes, then either *Feig's* or *Chayes'* principle of operation must be impermissibly changed. For example, because *Chayes* only teaches receiving "newsgroup data" as "matrices and arrays," *Feig's* principle of operation must be changed to receive a matrix of newsgroup information and somehow "strip" video frames from the matrix. Conversely, *Chayes'* principle of operation would have to be changed to

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receive a matrix of video frames that has been "stripped" from newsgroup data. Either of these changes is impermissible.

Regardless, even more changes are required. Because *Feig* strips video frames from a multimedia file, *Chayes'* principle of operation must be impermissibly changed to generate a "weighted graph" from these stripped video frames. This weighted graph would have to depict relatedness of two or more "stripped frames," such that the stripped frames are "represented as vertices and [the] cross-posts [are] represented as edges." *See Chayes*, at paragraph [0063]. Clearly, as video frames do not contain "cross-posts" (as newsgroups supposedly would), *Chayes'* principle of operation must be changed to process this non-existent information. Moreover, *Chayes'* principle of operation must also be impermissibly changed to segment the hypothetical weighted graph of "stripped frames" into "clusters" using a clustering algorithm. *See Chayes*, at paragraph [0066]. Somehow *Chayes'* principle of operation must be impermissibly changed to compute eigenvalues on non-existent information, determine an "Mcut ratio" using non-existent information, and then compare to a threshold.

Clearly, then, *Feig* cannot be combined with *Chayes* without making substantial changes to their respective principles of operation. If *Chayes* is combined with *Feig*, as the Office proposes, then either *Feig's* or *Chayes'* principle of operation must be changed. Because the patent laws forbid changing a principle of operation to support a *prima facie* case, any proposed combination of *Feig* with *Chayes* cannot support a *prima facie* case for obviousness.

The Panel is thus respectfully requested to remove the § 103 rejection of claims 1-20 based on any proposed combination of *Feig* with *Chayes*.